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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Best Available Copy

Office Action Summary

Application No.
08/733,072

Applicant(s)
Makoui et al.

Examiner
Ren Yan

Group Art Unit
2854



☒ Responsive to communication(s) filed on Jul 18, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12, 18-22, 25-30, 33-43, 49-63, 69-72, and 75-77 is/are pending in the application.

Of the above, claim(s) 22 and 25-30 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-12, 18-21, 33-43, 49-63, 69-72, and 75-77 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The request filed on 5-3-2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/733,072 is acceptable and a CPA has been established. An action on the CPA follows.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 8, 9, 18, 19, 33, 34, 49, 50, 53, 54, 60, 69-72 and 75-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klemmer(3,731,620) in view of Saueressig(4,685,393) and EP 181726. The patent to Klemmer teaches the very concept as disclosed and claimed in the present application to use a releasably attached sleeve with engraved pattern thereon on a embossing roller core so as to facilitate the replacement of the engraved sleeve without having to remove the entire embossing roller from the machine. See column 5, lines 10-31 and column 7, lines 46-62 in Klemmer for details. Klemmer may not disclose in detail how the embossing sleeve is releasably mounted on the roller core. Saueressig teaches the structure and method of employing a roller sleeve positioning means for releasably attaching a printing sleeve onto a roller core using pressurized gas as recited including the pressurized air passages and circumferential grooves 22-24. See the entire Saueressig reference for example. EP 181726 teaches a printing roll with a detachable sleeve the conventionality of providing a keyway(100, 102) on the roll core 6 to be mated with a

key(101, 105) on the inner surface of sleeve 1 so as to prevent rotation of the sleeve relative to the core. See Figs. 3 and 4 in EP 181726 for example. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the embossing roller of Klemmer with the properly disposed structure for providing pressurized gas as taught by Saueressig so as to facilitate the mounting and removing of the embossing sleeve and with key and keyway formations on the sleeve and roller core, respectively, as taught by EP 181726 in order to prevent rotation of the sleeve relative to the core when subjected to high printing pressure. With respect to claims 18, 49 and 69, the depth of such a groove would have been ultimately determined by those having ordinary skill in the art through routine experiment in order to achieve a desired outcome. Such a determination based on routine experiment would have been obvious to those skilled in the art.

Claims 20, 21, 51, 52, 71 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klemmer in view of Saueressig and EP 181726 as applied to claims 1, 33 and 53 above, and further in view of Julian(4,144,813). Klemmer, as modified by Saueressig and EP 181726 may not show the use of tapered roller core and sleeve. Julian teaches in a similar roller structure using pressurized gas to facilitate mounting of the sleeve the conventionality of using tapered roller core outer surface and sleeve inner surface so as to facilitate the mounting and detachment of the sleeve relative to the roller core. See the entire Julian reference for example. In view of the teaching of Julian, it would have been obvious to

one of ordinary skill in the art to provide the roller core and sleeve inner surface of Klemmer, as modified by Saueressig and EP 181726, in order to ease the sleeve mounting operation.

Claims 3-7, 35-40 and 55-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klemmer in view of Saueressig and EP 181726 as applied to claims 1, 33 and 53 above, and further in view of Kildune(5,266,257). Klemmer, as modified by Saueressig and EP 181726, may not disclose the material used for the engraved sleeve. Kildune discloses in the paragraph bridging columns 1 and 2 that it is conventional to provide an embossing roller core with a vulcanized rubber sleeve to carry out the embossing function. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the embossing roller of Klemmer with a vulcanized rubber sleeve as taught by Kildune. The mere application of a known material based upon its well known properties and intended use by those having ordinary skill in the art in order to obtain an expected outcome would involve no apparent unobviousness. With respect to the recited sleeve hardness in claims 3-5, 35-37 and 55-57, since the applied prior art references use the same material, it would appear that the broad hardness range as recited would inherently be met. Besides, due to the lack of disclosure showing any criticality, the hardness of the embossing sleeve employed would be determined based upon the type of material to be embossed, etc. and such a determination would be made by those having ordinary skill in the art through routine experiment in order to obtain the desired result.

Claims 10, 11, 12, 41-43 and 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klemmer in view of the applied prior art as applied to claims 9, 40 and 60 above, and further in view of Jones(3,404,254). Klemmer, as modified by the applied references, may not disclose how the sleeves are engraved. Laser engraving on the surface of cylindrical rollers has long been known and used in the art for its ability to generate accurate and sharp images. Jones teaches such a conventional use of laser engraving on cylindrical shaped roller bodies. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use laser technology to engrave the embossing pattern on the sleeve of Klemmer, as modified by the applied references, as taught by Jones in order to achieve improved image pattern on the sleeve. With respect to the broadly recited embossing pattern includes embossing elements having various shapes, since the particular laser engraving technique on the embossing sleeve is not disclosed and claimed as part of the present invention, the various shapes of the embossing elements in the embossing pattern are considered as a design preference based on the embossed images desired to be obtained. Such a design preference by those having ordinary skill in the art would involve no apparent unobviousness.

Applicant's arguments filed on 12-13-99 have been fully considered but they are not persuasive.

In response to applicant's argument that the applied Saueressig, EP 181726 and Julian references are all from nonanalogous art, it has been held that a prior art reference must either

be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all of the above three applied prior art references are in the field of applicant's endeavor, the printing art. It should be pointed out that embossing is a subset of printing in general and is classified under the same printing class 101(subclasses 3.1-32) under the U.S. Patent Classification System as that of Saueressig and Julian references, which belong to printing class 101, subclass 375. Furthermore, the teachings of the Saueressig, EP 181726 and Julian references are extremely pertinent to the particular problem with which the applicant was concerned, which was to facilitate the mounting and removing the sleeve on or from the roller core and to prevent rotation of the sleeve once mounted relative to the core when subjected to high printing pressure. Thus, it is believed that both conditions set by the Court have been met in the above applied rejections.

This is a Continued Prosecution Application of applicant's earlier Application No. 08/733,072. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren Yan whose telephone number is (703) 308-0978. The examiner can normally be reached on weekdays from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hilten, can be reached on (703) 308-0719. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-5841.



Ren Yan
Primary Examiner
Art Unit 2854

Ren Yan
October 10, 2000